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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,300	07/11/2003	Maria Cheek	AND/ 002	4326
1473	7590	09/10/2004	EXAMINER	
FISH & NEAVE 1251 AVENUE OF THE AMERICAS 50TH FLOOR NEW YORK, NY 10020-1105			GREEN, BRIAN	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/618,300

Applicant(s)

CHEEK ET AL.

Examiner

Brian K. Green

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 8-10,16,21,22 and 30-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,11-15,17-20 and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention: Species I. Figures 1-3;

Species II. Figure 4;

Species III. Figure 5;

Species IV. Figures 6-8;

Species V. Figures 9,10.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none of the claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

Art Unit: 3611

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Jeffrey D. Mullen on Aug. 16, 2004 a provisional election was made with traverse to prosecute the invention of Species I. (figures 1-3), claims 1-7, 11-15, 17-20, and 23-29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-10, 16, 21, 22, and 30-40 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Claims 8, 21, and 22 are directed to the non-elected embodiment shown in figures 6-8. Claims 9, 10, 15, and 16 are directed to the non-elected embodiment shown in figure 10.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the glue defined in claim 2 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### ***Specification***

The abstract of the disclosure is objected to because it contains the word "invention" on lines 3, 4, and 12. Also, the abstract is more than 150 words which is improper. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,11,15,17,19,20,24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lithwick (U.S. Patent No. 4,951,404).

Lithwick shows in figures 1-8 a greeting card comprising a first and second sheet segment (11 or just 40,12) folded about a fold line (19), an aperture (21) in the first sheet segment (11), a first transparent containment sheet (26), a second transparent containment sheet (25), the first and second sheets forming a container, and a substance (23) in the container. In regard to claim 2, the first and second containment sheets are glued, see column 2, lines 30-68. In regard to claim 3, Lithwick shows in figures 4 and 5 that the first containment sheet (26) is attached to one side (the outer side of the sheet segment) of the first sheet segment and the second containment sheet (25) is attached to the other side (the inner side of the sheet segment) first sheet segment. In regard to claim 11, the second containment sheet (15) is considered to be part of a third sheet segment (39) that is folded about a second fold line (18). In regard to claim 15, the aperture (21) is non-circular. In regard to claim 17, Lithwick discloses in column 3, lines 35-39 the idea of placing indicia (picture) on the second containment sheet. In regard to claim 19, the container of Lithwick is capable of performing the function of being opened, i.e. the container can be cut or the first and second containment sheets can be pulled apart to allow the substance to be removed from the container. In regard to claim 20, the container of Lithwick is capable of performing the function of having the container re-sealed, i.e. placing a piece of tape over the cut that was placed in the container to allow the substance to be removed or adding additional adhesive to the container to allow the container to be re-sealed after separating the two containment sheets to allow the substance to be removed. In regard to claim 25, the particles (23) are considered to be special effects particles.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lithwick (U.S. Patent No. 4,951,404).

In regard to claim 14, Lithwick does not disclose making the aperture circular. Lithwick discloses the idea of making the aperture rectangular but also discloses in column 3, lines 45-47 that the shape of the container (shape of container matches the shape of the aperture) is optional. It would have been an obvious matter of design choice to make the aperture circular since the applicant fails to define any advantage to making the aperture round and the shape taught by Lithwick would work equally well. In regard to claim 18, Lithwick does not disclose making the indicia in the form of a snowman. Lithwick discloses the idea of making the indicia in the form of a cat. It would have been an obvious matter of design choice to make the aperture circular since the applicant fails to define any advantage to making the aperture round and the shape taught by Lithwick would work equally well. Further, it is considered within one skilled in the art to make the indicia in any form as desired. The indicia defined by the applicant is not functionally related to the substrate and therefore does not distinguish the invention from the prior art. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983).

Claims 4-7,12-14, and 26-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Lithwick (U.S. Patent No. 4,951,404) in view of Hirsch (U.S. Patent No. 6,484,425).

In regard to claims 4 and 29, Lithwick does not disclose the idea of making the substance within the container in the form of glitter. Hirsch shows in figures 1-4 a display that includes an aperture in a sheet which receives a transparent container (11) which includes a liquid and particles therein. Hirsch discloses in column 4, lines 15-20 that the particles can be glitter. In view of the teachings of Hirsch it would have been obvious to one in the art to modify Lithwick by making the substance in the container in the form of glitter since this would create a more amusing and aesthetically pleasing display. In regard to claims 5 and 28, Lithwick does not disclose the idea of making the substance within the container in the form of confetti. Hirsch shows in figures 1-4 a display that includes an aperture in a sheet which receives a transparent container (11) which includes a liquid and plurality of particles therein. Hirsch discloses in column 4, lines 15-20 that the particles can be glitter, colored plastic, pellets, chips, etc. The use of confetti is well known in the art. In view of the teachings of Hirsch and the fact that confetti is conventional in the art it would have been obvious to one in the art to modify Lithwick by making the substance in the container in the form of confetti since this would create a more amusing and aesthetically pleasing display. In regard to claims 6,7,12,13,26, and 27, Lithwick does not disclose the idea of placing liquid in the container and the idea of placing particles within the liquid. Hirsch shows in figures 1-4 a display that includes an aperture in a sheet which receives a transparent container (11) which includes a liquid and particles therein. Hirsch

Art Unit: 3611

discloses in column 4, lines 15-20 that the particles can be glitter, plastic strips, colored plastic, sponge, rubber, metal, beans, pellets, etc. In regard to claims 6 and 26, in view of the teachings of Hirsch it would have been obvious to one in the art to modify Lithwick by placing a liquid within the container since this would create a more amusing and aesthetically pleasing display. In regard to claims 7, 12, 13, and 27, in view of the teachings of Hirsch it would have been obvious to one in the art to modify Lithwick by placing a liquid having particles within the container since this would create a more amusing and aesthetically pleasing display. In regard to claims 12 and 13, Hirsch discloses the use of both floating and sinking particles, see column 4, lines 15-25. In regard to claim 14, Lithwick does not disclose making the aperture circular. Hirsch shows in figure 2 the idea of making an aperture in a cover circular. In view of the teachings of Hirsch it would have been obvious to one in the art to modify Lithwick by making the aperture circular since this would create a more aesthetically pleasing display and it is considered within one skilled in the art to aperture in any shape as desired.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lithwick (U.S. Patent No. 4,951,404) in view of Fine et al. (U.S. Patent No. 6,438,878) or Gregory-Gillman (U.S. Patent No. 6,151,823).

Lithwick does not disclose the idea of tinting the first containment sheet. Fine et al. shows a display device in which the walls (140,150) are tinted with a color, see column 5, lines 38-42. Gregory-Gillman discloses the use of a pocketed display device that includes a tinted front wall, see column 7, lines 28-36. In view of the teachings of Fine et al. or Gregory-Gillman it would have been obvious to one in the art to modify Lithwick by tinting the first containment sheet



Art Unit: 3611

since this would create a more amusing and aesthetically pleasing display and would help to protect the substance within the container from being damaged by the sun.

Claims 5 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lithwick (U.S. Patent No. 4,951,404) in view of Borden (U.S. Patent No. 5,197,213).

Lithwick does not disclose the idea of making the substance within the container in the form of confetti. Borden shows in figures 1-4 a display that includes a transparent holder that includes confetti therein, see column 5, lines 5-10. In view of the teachings of Borden it would have been obvious to one in the art to modify Lithwick by making the substance in the container in the form of confetti since this would create a more amusing and aesthetically pleasing display.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jacobson et al., Mozes, Boone, and Mullins teach the use of displays that includes an aperture and a liquid within a container attached to the display.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
BRIAN K. GREEN  
PRIMARY EXAMINER

Bkg  
Sept. 6, 2004